REMARKS

Claims 1, 5-10, 20, 24-29, 39 and 50 are pending but stand rejected. Claims 2-4, 11-19, 21-23, 30-38, and 40-49 have been cancelled. Claims 1, 6, 20, 25, 39 and 50 have been amended. In view of the amendments and following remarks, the Applicant requests the Examiner's thoughtful consideration

CLAIM REJECTIONS – 35 USC § 101:

Claims 1, 5-8, 39, and 50 stand rejected as being directed to non-statutory subject matter. Claims 1, 6, 39, and 50 and paragraph [0045] of the specification have been amended to address the Examiner's concerns. In particular Claim 1 has been amended so that the process is tied to a physical apparatus. That apparatus includes a scan engine and one of a print engine, a facsimile engine, an e-mail engine, and a file manager. Claim 39 has been amended to recite a computer readable medium. Claim 50 has been amended to be tied to a physical apparatus. The Specification has been amended to remove reference to carrier signals from the definition of computer readable medium.

CLAIM REJECTIONS – 35 USC § 103:

Claims 1, 5-8, 20, 24-27, 39, and 50 stand rejected under 35 U.S.C. 103 as being unpatentable over USPN 6,169,873 issued to Connolly. The Applicant respectfully maintains the argument presented in the appeal brief filed October 8, 2008. In particular, the Examiner has failed to show that one of ordinary skill in the art would have reasonably modified Connolly in the manner suggested by the Examiner.

Claim 1 is directed to a digital image selection method and as, as amended, recites the following:

1.   causing a scan engine to initiate a scan of an ordered set of physical objects;

2. obtaining a first digital image of a first side of a physical object, the physical object being a first of the ordered set of physical objects scanned by the scan engine;

3. examining the first digital image to determine if it is substantially blank;

4. if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects scanned by the scan engine, and sending the first set of digital images for processing by one of a print engine, a facsimile engine, an e-mail engine, and a file manager;

5. only if the first digital image is substantially blank, obtaining a second digital image of a second side of the physical object, the physical object being the first of the ordered set of physical objects scanned by the scan engine and examining the second digital image to determine if it is substantially blank;

6. if the first digital image is substantially blank and the second image is not substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects scanned by the scan engine, and sending the second set of digital images for processing by one of the print engine, the facsimile engine, the e-mail engine, and the file manager.

To summarize, a digital image of the first side of an initial page of a set of pages is obtained. It is determined if that digital image is blank. Only if blank, a second digital image of the second side of the initial sheet is obtained. Then, if the first digital image is determined to be blank and the second digital image is not, the second sides of set of pages are obtained and sent for processing. If the first digital image not blank, digital images of the first sides of set of pages are obtained and sent for processing. In other words, if the first digital image is not blank the first set of digital images are obtained and

sent for processing. Only if the first digital image is blank, the second digital image is obtained. If the second digital image is not blank, digital images of the second sides of set of pages are obtained and sent for processing.

At page 3 of the September 18, 2008 office action, the Examiner admits that Connolly does not "disclose checking only one image for face orientation, and then making the assumption for the rest of the sheets in the stack." Instead, the Examiner contends that it would be modify Connolly to "to provide checking only one image for face orientation, and then making the assumption for the rest of the sheets in the stack for the purpose of increasing speed. The Appellant, respectfully disagrees.

Connolly, at column 6, lines 31-33 scanning both sides of a sheet in steps 33-35 before and determination is made as to whether either side is blank in steps 41 and 43. Such is required to achieve Connolly's express purpose of determining whether or not sheets placed in a sheet feeder have a simplex or a duplex image presentation. *See, e.g.*, Connolly, Abstract. Further, Connolly expressly states:

> Referring to FIG. 2, a document provided to the sheet feeder 13 (FIG. 1) is scanned in order to determine, **among other required functions**, if images appear on one or both sides of the first pages.

Connolly, col. 6, lines 28-31 (emphasis added). In other words, Connolly expressly labels the function of determining whether or not a document placed on a sheet feeder is double sided as **required**.

The US Supreme Court has recently stated:

> [A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed

discoveries almost of necessity will be combinations of what, in some
sense, is already known.

KSR Int'l Co. v. Teleflex, Inc, 550 U.S. ___, 127 S. Ct. 1727 (April 30, 2007) (pages 15-
16 of the Bench Opinion). Such is consistent with MPEP § 2143.01(V) which provides:

> If proposed modification would render the prior art invention being
> modified unsatisfactory for its intended purpose, then there is no
> suggestion or motivation to make the proposed modification. *In re Gordon,*
> 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

MPEP §2143.01(V).

At a minimum, the Examiner must, in light of *KSR,* establish that a person
of ordinary skill in the art would have reasonably modified Connolly in the manner
suggest. The Appellant respectfully maintains that such a showing cannot be
made. Connolly requires that both sides of at least the first sheet of a document
be scanned to determine whether or not the document is double sided.
Modifying Connolly to scan the second side only if the first side is not blank is not
an option. The modification would render Connolly unsuitable for its intended
purpose. Thus one of ordinary skill in the art would not be inclined to modify
Connolly in the manner suggested by the Examiner.

For at least this reason, Claim 1 and Claims 5-8 are patentable over
Connolly.

Claim 20 is directed to a computer readable medium having instructions for
implementing the method of Claim 1. For at least the same reasons Claim 1 is
patentable, so are Claim 20 and Claims 23-29 which depend from Claim 20.

Claim 39 is directed to a system having various components configured to
implement the method of Claim 1. For at least the same reasons Claim 1 is patentable,
so is Claim 39.

Claim 50 is directed to a system having various means for implementing the method of Claim 1. For at least the same reasons Claim 1 is patentable, so is Claim 50.

Claims 9 and 28 were rejected as being unpatentable over Connolly in view of US Pub 2003/0048470 to Garcia. Claims 9 and 28 each depend from an allowable base and is allowable based at least in part on that dependency.

Claims 10 and 29 were rejected as being unpatentable over Connolly in view of Okubo. Claims 9 and 28 each depend from an allowable base and is allowable based at least in part on that dependency.

CONCLUSION: Claims 1, 5-10, 20, 24-29, 39 and 50 are felt to be in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited.

Respectfully submitted,

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